

### REMARKS

Claims 8-14, 26-30, and 33-39 are pending in this application, all of which stand rejected as a result of the December 22, 2004 Office Action. In particular, all claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt (U.S. Patent No. 6,662,230) in view of Pogue (U.S. Patent No. 6,112,240), and in further view of Huston (U.S. Publication No. 2002/0007402). Applicant respectfully disagrees with the grounds for rejection as summarized below.

The section 103(a) rejection set forth in the December 22, 2004 Office Action appears to be identical to the section 103(a) rejection set forth in the May 6, 2004 Office Action. Applicant responded to those grounds for rejection in the paper filed on July 30, 2004 ("the Prior Response"), and need not repeat those arguments verbatim here. However, there is one point that applicant raised in the Prior Response, and on which applicant wishes to focus the Examiner's attention now: Eichstaedt teaches away from independent claims because it contravenes the teachings of Eichstaedt to provide information to a selected user – e.g., to provide a web page (claims 8 and 33), or to provide a customized version of a web page (claim 26). When Eichstaedt selects a user, the user is being identified as a possible robot to whom all further access to the web site will be denied. By contrast, the present invention selects users who are to receive web pages based on certain stored data.

In particular, claims 8 and 33 each call for "copying data from each of the selected user's ... computing devices" and "providing a web page to each of the selected group of users based on the copied data". Additionally, claim 26 calls for a "first computing device" that provides "a customized version of [a] web page to each of [a plurality of] second computing devices based on customization information" and "a throttle module which selects certain ones of said second computing devices for storage of their respective customization information." As to each of these claims, the Examiner has read the feature of "selecting" certain users or devices onto Eichstaedt's feature of identifying certain clients as robots. The Examiner then applies Pogue and Huston in various combinations to show the features of providing web pages to the selected users or devices.

Applicant has argued, in the Prior Response, that Eichstaedt does not provide web pages to selected users or devices because Eichstaedt regards these selected users or devices

as robots to whom no information will be provided. Applicant acknowledges that the Examiner has not relied on Eichstaedt as teaching the feature of providing web pages to the selected users. However, applicant respectfully submits that the Examiner has overlooked the fact that Eichstaedt's teachings are so incompatible with providing web pages to the selected users that the proposed combination of references is unsupportable. The obviousness rejection would only be supportable if one of ordinary skill in the art would read Eichstaedt's teaching of denying web access to selected users, and would then be motivated to modify that teaching to then *provide* those selected users with web pages. This line of reasoning, however, is unjustified. Teaching the act of *denying access to* information does not motivate one to *provide* information.

In short, applicant respectfully submits that the prior art applied by the Examiner would not render the claims obvious because Eichstaedt's teaching of denying all information to robots would lead one of ordinary skill in the art away from the above-quoted language from claims 8, 26, and 33.

The Examiner appears to fault applicant's prior response under 37 C.F.R. §§ 1.111(b), (c), on the ground that the response allegedly does not "point[] out how the language of the claims patentable distinguishes them from the references." Applicant respectfully submit that the Prior Response, and the positions expressed therein, constitute a full and *bona fide* reply under Rule. 1.111, and that the Examiner has overlooked the nature of the argument raised.

First, as to Rule 1.111(c), this subsection applies only when the claims have been amended in response to a rejection, and is inapplicable here. In the Prior Response, applicant amended claim 14 to correct a typographical error without changing the scope of the claims. Additionally, applicant added claims 33-39 and noted in that paper that new claims 33-39 are computer-readable medium claims with limitations substantially similar to those contained in method claims 8-14. Having explained the patentability of claims 8-14, and having connected claims 33-39 with claims 8-14 in this way, applicant's position as to the patentability of claims 33-39 should be clear. Additionally, on page 5 of the December 22, 2004 Office Action, the Examiner appears to acknowledge this correspondence between claims 33-39 and 8-14, so it is unclear what additional arguments the Examiner seeks. In view of these observations, it is unclear why the Examiner has raised Rule 1.111(c).

As to Rule 1.111(b), the Examiner suggests that applicant has not met the requirements of that rule, and apparently refers to the portion of Rule 1.111(b) that states: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references." Applicant has pointed out the distinction between the claims and the applied references. Simply stated, the applied references, taken together, do not teach or suggest that a selected user is provided with a web page (as in claims 8 and 33), much less a customized version of a web page (as in claim 26), because Eichstaedt teaches away from this feature. This (as well as the other distinctions raised in the Prior Response), point out the specific distinctions that applicant believes render the claims patentable over the references. Contrary to the Examiner's assertion, these arguments are not a mere "general allegation that the claims define a patentable invention." Rather, applicant has pointed to specific language in the claims, and has explained why the applied references teach away from this language, which is recognized by MPEP 2145(X)(D) as a legitimate rebuttal to an obviousness rejection, with significant support in case law. Applicant has directed the Examiner's attention to the specific language from independent claims 8, 23, and 36, and has explained why the applied references teach away from this language. In view of these remarks, applicant respectfully submits that these arguments are not merely a "general allegation" that the claims are patentable, and request that the Examiner consider in detail the arguments that applicant has made.

Additionally, applicant notes that the Prior Response explains how features recited in claims 13, 27, and 28 differ from the prior art, and the Examiner has not addressed those arguments.

### Conclusion


Applicant has demonstrated above that the independent claims are patentable over the applied prior art. Additionally, applicant has raised various arguments concerning claims 13, 27, and 28 in the Prior Response that demonstrate the patentability of those claims and that have not been addressed by the Examiner. With the independent claims having been shown to be patentable over the applied prior art, the dependent claims are patentable at least by reason

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of their dependency. Thus, applicant submits that this case is in condition for allowance, and requests that the Examiner reconsider the Final Rejection and issue a Notice of Allowance.

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Peter M. Ullman  
Registration No. 43,963

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439